



Attorney's Docket No.: 01997-253005

#11
mdj
6-28-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jae S. Lim
Serial No. : 09/335,376
Filed : June 17, 1999
Title : ENCODING, DECODING AND COMPRESSION OF AUDIO-TYPE DATA
USING REFERENCE COEFFICIENTS LOCATED WITHIN A BAND OF
COEFFICIENTS

Art Unit : 2786
Examiner : Smits, T.

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESPONSE

This is responsive to the office action mailed January 11, 2000

The Examiner has requested clarification of the error relied upon to support the reissue application. Simply put, prior prosecution failed to claim significant inventive aspects disclosed in the original application. While the pending reissue claims relate to the same technological area as the previously prosecuted claims, the pending claims are directed to substantially different subject matter.

The Examiner has rejected the pending claims as an attempt to recapture subject matter surrendered during prosecution. The examiner is urged to reconsider and withdraw the rejection for several fundamental reasons.

Most fundamentally, there never was any surrender of subject matter, and thus recapture is an impossibility as a matter of law. Review of the prosecution history of the '508 family (i.e., U.S. Pat. Nos. 5,394,508, 5,369,724, 5,640,486, and 5,625,746) shows that every independent claim presented was eventually allowed and issued without any amendment necessitated by prior art. Thus, applicants never surrendered any subject matter..

It is well settled that there must be a deliberate surrender of subject matter as a consequence of prior art for the recapture rule to come into play, and that merely cancelling

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

June 12, 2000

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Julia Soherly

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Julia Soherly